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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/472,972	12/28/1999	YOJI KAMEO	0445-0275P	9431

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EXAMINER	
KIDWELL, MICHELE M	
ART UNIT	**PAPER NUMBER**
3761	

DATE MAILED: 09/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/472,972	KAMEO ET AL.	
	Examiner	Art Unit	
	Michele Kidwell	3761	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *14 July 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,2,4-15 and 17-20* is/are pending in the application.

4a) Of the above claim(s) *2,6-10,13-15 and 17-20* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,4,5,11 and 12* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *102403;110503*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

Applicant's election of Species 1 (figures 1 – 2) and corresponding claims 1, 4 – 5 and 11 – 12 in the reply filed on July 14, 2004 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Claims 2, 6 – 10, 13 – 15 and 17 – 20 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on July 14, 2004.

Claim Interpretation

With respect to claims 1, 4 – 5 and 11 – 12, the examiner notes that on page 6 of the instant specification, the applicant sets forth specific conditions that exist to allow for the claimed limitations. Specifically, the applicant states that the claimed limitations require the conditions of temperature of 20°C and humidity of 65% and dropping of 1 g of the solution from 1 cm above the core. Hereinafter, the examiner interprets the claimed limitations to encompass the provisions of temperature, humidity and distance dropped from above the core as set forth on page 6 of the applicant's specification.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 4 – 5 and 11 – 12 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Van Tillburg (5,489,283).

Initially, the examiner notes that claims 1 and 4 – 5 are considered product-by-process claims because in order to determine the end product (i.e., a sanitary napkin comprising an absorbent body and a pair of left and right wing portions each including a liquid-retentive absorbent core), the test of dropping the solution onto the article must be performed. In light of such, the applicant is reminded that:

"[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985) (citations omitted). See MPEP 2113.

Further:

> "[T]he lack of physical description in a product-by-process claim makes determination of the patentability of the claim more difficult, since in spite of the fact that the claim may recite only process limitations, it is the patentability of the product claimed and not of the recited process steps which must be established. We are therefore of the opinion that when the prior art discloses a product which reasonably appears to be either identical with or only slightly different than a product claimed in a product-by-process claim, a rejection based alternatively on either section 102 or section 103 of the statute is eminently fair and acceptable. As a practical matter, the Patent Office is not equipped to manufacture products by the myriad of processes put before it and then obtain prior art products and make physical comparisons therewith." *In re Brown*, 459 F.2d 531, 535, 173 USPQ 685, 688 (CCPA 1972).

With respect to claim 1, Van Tilburg discloses a sanitary napkin comprising an elongate absorbent body (216) and a pair of left and right side wing portions (224, 224') disposed at longitudinal opposite left and right sides of the absorbent body (figure 2) wherein each of the wing portions includes a liquid retentive wing portion absorbent core as set forth in col. 6, lines 9 – 11. Van Tilburg also discloses the flap absorbent core to be less tan 80cm^2 in col. 6, lines 32 – 38. Therefore, Van Tilburg provides a sanitary napkin wherein after 1 minute after dropping 1 g of a physiological solution of sodium chloride onto a liquid retentive wing portion absorbent core, the solution disperses to an area of the wing portion absorbent core measuring no larger than 80cm^2.

In the alternative, it would have been inherent that the sanitary napkin of Van Tilburg will provide the claimed test results because the structure of the sanitary napkin of Van Tilburg is identical to that of the claimed invention (i.e. providing a sanitary napkin with left and right side wing portion wherein each wing portion includes a liquid retentive wing portion absorbent core) and if the product in the product-by-process claim

is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.

Regarding claim 4, see the rejection of claim 1. Additionally, Van Tilburg discloses the liquid retentive wing portion absorbent core being comprised of absorption paper in col. 6, lines 20 – 21.

With respect to the embossments, the examiner contends that it would have been obvious to one of ordinary skill in the art to provide the sanitary napkin of Van Tilburg with embossments because it is well known in the art that the use of embossments aids in the prevention of undesirable leakage and provides integrity between the cover and the absorbent which aids in holding the article together during removal of the article from the undergarment. Absence a critical teaching and/or unexpected result, the type and position of embossments are deemed obvious matters of design choice which do not patentably distinguish the claimed invention from the prior art.

With respect to claim 5, see the rejection of claim 1. It would have been inherent that the sanitary napkin of Van Tilburg will provide the claimed test results because the structure of the sanitary napkin of Van Tilburg is identical to that of the claimed invention (i.e. providing a sanitary napkin with left and right side wing portion wherein each wing portion includes a liquid retentive wing portion absorbent core) and if the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.

As to claim 11, Van Tilburg discloses a sanitary napkin wherein the wing portion absorbent core extends substantially an entire length of the sanitary napkin as set forth in figure 1.

With reference to claim 12, Van Tilburg discloses a sanitary napkin wherein each of wing portions includes a liquid permeable topsheet and a liquid impermeable backsheet with the liquid retentive wing portion absorbent core located therebetween (col. 6, lines 9 – 11), said liquid retentive wing portion absorbent core extending substantially an entire width of the sanitary napkin in partial overlapping relationship with the elongate absorbent body as set forth in col. 6, lines 11 –13 and in figure 2.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michele Kidwell whose telephone number is 703-305-2941. The examiner can normally be reached on Monday - Friday, 7:30am - 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Larry Schwartz can be reached on 703-308-1412. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Michele Kidwell
Examiner
Art Unit 3761